

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

IN RE: BROWNELL, Peter R.)
)
SERIAL NO: 10/752,879)
) APPEAL NO. _____
FOR: METHOD FOR ON-LINE PARTS)
ORDERING)
) REPLY BRIEF ON APPEAL
FILED: January 6, 2004)
)
GROUP ART UNIT: 3627)
)
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To the Commissioner of Patents and Trademarks
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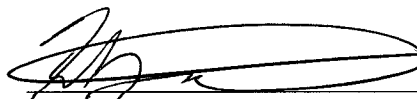
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Kurt Van Thomme

I. INTRODUCTION

In the Examiner's Answer, the Examiner for the most part fails to address the points raised in Applicant's Appeal Brief. Instead, the Examiner time and time again merely offers unsupported conclusions. Nothing in the Examiner's Answer therefore changes the conclusions that are evident from Applicant's Appeal Brief: the Examiner's rejection of claims 1-21 as obvious in light of Uemura is erroneous and should be reversed.

II. ARGUMENT

A. The Examiner fails to address Applicant's argument that Uemura is nonanalogous art and thus improperly relied upon under § 103

In response to Applicant's argument that Uemura is nonanalogous art, the Examiner states that "the fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." *See* Examiner's Answer, p. 7. This response completely ignores whether Uemura is proper prior art to be relied upon under § 103(a), the issue raised in Applicant's brief.

A reference should not be considered under 35 U.S.C. § 103 if "it is not within the field of [the] inventor's endeavor and was not directly pertinent to the particular problem with which the inventor was involved." *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 858 (Fed. Cir. 1985). As stated in the specification, Applicant's invention is generally directed toward "on-line ordering of component parts, and in particular to the on-line ordering of component parts for guns from a supplier." Specification, ¶ 1. Conversely, Uemura is directed towards ordering parts for "equipment that can support a direct monitoring and

maintenance of its own components [sic] parts between the user and the manufacturer of the equipment." (Uemura, ¶ 1.) Under *King Instrument*, these are not the same "field of endeavor," as Applicant is seeking to facilitate ordering between a consumer and a supplier, whereas Uemura is seeking to facilitate ordering between an end-user of equipment and a manufacturer of that equipment, circumventing the supplier altogether.

Uemura is also not "directly pertinent to the particular problem with which the inventor was involved." *King Instrument*, 767 F.2d at 858. Nowhere in Uemura is the issue of ordering through a supplier's website even contemplated. In fact, in stark contrast to Applicant's novel supplier based ordering system, Uemura's goal is to eliminate the supplier from the ordering process. (Uemura, ¶ 51.) Further, Uemura contemplates directly ordering replacement parts from the machine whose parts need replaced to the manufacturer of the parts, rather than doing so via a website. (Uemura, ¶ 17.)

Accordingly, because Uemura is neither in the same field of endeavor nor relevant to the particular problem addressed by Applicant, Uemura should not be considered under a § 103(a) obviousness analysis. *See King Instrument*, 767 F.2d at 858; *see also* MPEP § 2141.01(a). Nothing in the Examiner's Answer contradicts this conclusion. As all the appealed rejections rely upon Uemura, this is sufficient reason to overturn all the rejections and place the application in condition for allowance.

B. Even if Uemura is considered under § 103(a), it does not render the claimed invention obvious

The Examiner's answer reveals that in many cases the Examiner has misapprehended the claimed invention or the scope of Uemura's disclosure. Uemura does not teach or

otherwise disclose many of the elements in claims 1-21 of the invention, nor would the claimed invention involve only obvious modifications of Uemura's disclosure. The Examiner's Answer provides no further evidence that the claimed invention is obvious. Thus, the Examiner's conclusory obviousness rejections remain improper. *See In re Chu*, 66 F.3d at 298.

1. Uemura does not teach or otherwise disclose the provision of an interactive component parts schematic that is provided over an intermediary supplier's computer network as is required by claims 1-21

As noted in Applicant's Appeal Brief, claims 1-21 all include limitations which require the provision of an interactive schematic that is provided over a computer network so that a user can access that schematic easily and use it to select the component in the overall ordering function. Uemura simply does not teach or otherwise disclose this group of elements. Uemura does disclose a parts diagram in paragraph 18. However, it must be understood that the parts diagram in Uemura is not provided over or by a computer network (*i.e.*, a web site) providing the ordering functionality. Instead, the Uemura parts diagram is stored in the memory of the user's the data processor of the user's product, such that it does not directly effectuate or cause the selection functionality portion of the ordering system. (Uemuara, ¶ 18.) There is likewise no motivation to modify Uemura to provide this functionality.

In the Examiner's answer, he states that "Uemura indeed discloses that the schematic is interactive by means of a selectable link on the schematic to select to receive an associated description of the selected part." Examiner's Answer, p. 7. Even if true, this does not change

the fact that Uemura nowhere discloses that such a schematic is provided over the computer network rather than locally on the machine whose replacement parts are to be ordered.

Uemura never contemplates or suggests such a modification. This cannot form the basis of a proper obviousness rejection because it does take into account the full teachings of Uemura.

See MPEP § 2141.02.

Accordingly, this element is neither taught by Uemura, nor is such a modification suggested, and the Examiner has thus not established a *prima facie* case of obviousness for any of the claims. For this reason alone, the Examiner's 35 U.S.C. § 103 obviousness objections should be overturned, and claims 1-21 are in condition for allowance.

2. Contrary to the Examiner's assertion, adding multiple manufacturers is not a "mere duplication of the essential working parts of" Uemura as required by claims 1-21

In the Examiner's answer, he states that providing sales of parts by multiple manufacturers "does not involve more than mere duplication of the essential working parts of the device of Uemura." Examiner's Answer, p. 7. This assertion is contrary to the express teachings of Uemura. Indeed, Uemura teaches away from such a modification, because one of the benefits of Uemura is the elimination of the "middle-man." (Uemura, ¶ 51.) Uemura specifically states that one of the problems it resolves is "the problem of parts being ordered from someone other than the manufacturer." (*See* Uemura, ¶ 8.) Uemura further states that "generic replacement parts can be avoided, since there is no possible decision by an intermediate dealer to use general purpose parts instead of the genuine parts." (Uemura, ¶ 16 (emphasis supplied).)

Thus, modifying Uemura to provide support for multiple manufacturers in order to create the claimed invention would require contradicting the express teachings of Uemura that only one manufacturer can be used. This cannot form the basis of a proper obviousness rejection because it does take into account the full teachings of Uemura. *See* MPEP §§ 2141.02, 2145. Accordingly, this element is neither taught by Uemura, nor is such a modification suggested, but rather is taught away from. The Examiner has thus not established a *prima facie* case of obviousness for any of the claims. For this reason alone, the Examiner's 35 U.S.C. § 103 obviousness objections should be overturned, and claims 1-21 are in condition for allowance.

3. It would not have been obvious to one of ordinary skill in the art to modify Uemura to provide more than one name and part number per part as required by claims 7, 13, and 15

In his answer, the Examiner states that providing more than one name and part number per part constitutes "mere changes alone in printed matter or other non-functional descriptive material are insufficient to impart patentability to an otherwise unpatentable invention." Respectfully, it appears that the Examiner has misapprehended the nature of the claimed invention. Addition of multiple part names and numbers is not mere duplication of parts in the context of the claimed invention, but rather is necessary to implement support for providing parts for multiple manufacturers as set forth in the prior section. As the Examiner recognizes, Uemura does not disclose these limitations (February 7, 2006 Office Action, pages 4). As discussed above, because Uemura is specifically directed to a single manufacturer system, it would not be obvious to modify Uemura to add multiple names and

numbers for the same manufacturer's parts. Therefore, it is respectfully urged that the Examiner's obviousness objections to at least claims 7, 13 and 15 should be overturned and those claims are in a condition for allowability for this independent reason.

4. Examiner's argument that Applicant's intended use is not relevant to patentability is contrary to law

With regard to claims 3 and 8-21, the Examiner merely states that "a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art." Examiner's Answer, p. 8, B4-B5. This statement, while true in the context of *apparatus* claims, is not the case for *method* claims. See *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002). All claims in the instant application are *method* claims, thus the Examiner's argument regarding intended use is contrary to established law. As the Examiner provides absolutely no other grounds to rebut Applicant's arguments, the Examiner's 35 U.S.C. § 103 obviousness objections for claims 3 and 8-21 should be overturned, and claims 3 and 8-21 are in condition for allowability.

5. The Examiner's Answer ignores virtually all elements of claim 19

In his Answer, the Examiner states with regard to claim 19 that Uemura "discloses that the parts diagram is provided over the computer network 7." Examiner's Answer, p. 9. Respectfully, this argument ignores at least ten (10) elements of claim 19. The Examiner simply has not provided sufficient grounds to maintain the obviousness rejection of claim 19 for the reasons set forth in Applicant's Appeal Brief, pp. 16-18. Accordingly, it is

respectfully urged that the Examiner's obviousness objections to at least claim 19 should be overturned, and claim 19 is in a condition for allowability for this independent reason.

6. Uemura does not disclose the provision of a web site for the customer to order replacement parts as required by claims 8-18

In his Answer, the Examiner states that Uemura "discloses providing a website for the customer to visit to order the part." Examiner's Answer, p. 9. Applicant disagrees. The Examiner contends, as he did in his final rejection, that paragraph 36 of Uemura teaches the provision of a website. (February 7, 2006 Office Action, page 6.) While paragraph 36 does state that the connection between the apparatus and the manufacturer can be through an Internet link, this means the direct link is established using the Internet as a medium—not that the analyzer's data processor (or the customer) accesses a web site created by the manufacturer. Uemura at most teaches a direct link between the analyzer's data processor and the manufacturer's data process which can be over the Internet, but it does not teach a customer accessing a web site provided by a supplier. Therefore, it is respectfully urged that the Examiner's obviousness objections to at least claims 8-18 should be overturned and those claims are in a condition for allowability for this independent reason.

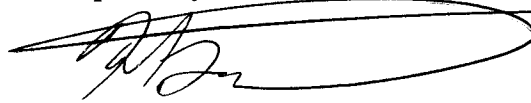
III. CONCLUSION

It is respectfully submitted that consideration of the entire record of the application, including Applicants' specification, the precise wording of Applicants' claims as a whole, the full teachings of Uemura, and the unrebutted evidence of record, supports the conclusion that as to the claims set forth herein, a *prima facie* case of obviousness has not been made and the

evidence supporting non-obviousness has not been rebutted. It is respectfully submitted that reversal of the sole rejection, obviousness, is mandated.

No fees or extensions of time are believed to be due in connection with this Reply Appeal Brief; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'KVT', is written over a horizontal line.

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